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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/29/2005

Leonid M. Kofman

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EXAMINER

SEO, JUSTIN

ART UNIT

PAPER NUMBER

2861

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,957	Applicant(s) KOFMAN ET AL.	
	Examiner JUSTIN SEO	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/2006 and 6/29/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Without conceding to the correctness of applicants' remarks, the restriction requirement has been withdrawn.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig. 6 does not show reference number "90". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2861

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1, 27-29, and 32** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Regarding **claim 1**, the phrase “and shape” is new matter.
6. Dependent claims 22-31 are considered rejected for incorporating defects from rejected parent claim.
7. Regarding **claim 27**, the phrase “attached to a bottom surface of the directing tray” is new matter.
8. Regarding **claim 28**, the phrase “wherein the directing tray comprises two pairs of flanges that flank the two gears and the two racks, respectively, for preventing lateral displacement between the two gears and the two racks” is new matter.
9. Regarding **claim 32**, in “a recess corresponding to the size and shape of the food item”, the phrase “and shape” is new matter.
10. Dependent claims 33-38 are considered rejected for incorporating defects from rejected parent claim.
11. Regarding **claim 29**, the phrase “and shape” is new matter.
12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2861

13. **Claim 37** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Regarding **claim 37**, the phrase “as the directing tray is moved in the first direction” is unclear because it is unclear whether printing occurs simultaneously with the movement of the tray, or between movements of the tray. Further, the specification does not appear to clarify this lack of clarity.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. **Claims 21-23, 31-34, and 37-38** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kofman et al. (US 6,230,073 B1)**.

Regarding **claim 21**, Kofman discloses an apparatus comprising:

- at least one cassette (see Fig. 11 and column 7, lines 52-63 and column 8, lines 3-7) including a recess corresponding to a variable size and shape of the food item (This is inherent in column 7, lines 52-63 and column 8, lines 3-7.) in order to receive the food item therein (see column 7, lines 52-63 and column 8, lines 3-7)

Art Unit: 2861

- a directing tray for receiving the at least cassette (see 104, Fig. 15 and column 8, lines 3-7)
- a guide mechanism (see the parallel bars in Fig. 15) for receiving the directing tray (Note that it is inherent that 104 must be received by the parallel bars of Fig. 15.), guiding the directing tray in a first direction (see Fig. 15), and maintaining a planar height of the directing tray (see Fig. 15)
- a printing device that is moveable within a plane above the directing tray, for printing an image onto the food item (see 56 and 106, Fig. 15)

Regarding **claim 22**, Kofman further discloses wherein a depth of the recess of the at least one cassette is determined based upon a thickness of the food item (this is inherent in Kofman), such that a top surface of the food item is positioned an optimal distance from the printing device when the directing tray receiving the at least one cassette is positioned below the printing device (See column 7, lines 52-63, wherein the top surface of the food item is either flush or a notch lower than a rim 88 of the frame.).

Regarding **claim 23**, Kofman further discloses a computer for receiving an image and for controlling the printing device such that the received image is printed onto the food item (inherent in Kofman).

Regarding **claim 31**, Kofman further discloses wherein the printing device prints the image onto the food item using edible ink or edible food dye (inherent in Kofman).

Regarding **claim 32**, please note the rejection as set forth above with respect to claim 21.

Art Unit: 2861

Regarding **claim 33**, please note the rejection as set forth above with respect to claim 23.

Regarding **claim 34**, please note the rejection as set forth above with respect to claim 22.

Regarding **claim 37**, Kofman further discloses wherein printing, by the printing device, the image onto the food item comprises moving the printing device in a second direction and a third direction within the plane (see Fig. 15), the second and the third directions being perpendicular to the first direction (see Fig. 15), in order to linearly apply the image to onto the food item as the directing tray is moved in the first direction below the printing device (inherent in Kofman).

Regarding **claim 38**, please note the rejection as set forth above with respect to claim 31.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claim 24** rejected under 35 U.S.C. 103(a) as being unpatentable over **Kofman et al. (US 6,230,073 B1)**.

Regarding **claim 24**, Kofman discloses all the limitations introduced in claim 21.

Kofman does not explicitly to disclose a motor including a motor shaft for providing a rotational movement to move the directing tray in the first direction.

However, such a limitation is obvious in view of the fact that a rastering print head is used to print upon the food item in Kofman. It is obvious to one of ordinary skill in the art that a rastering print head would require precisely controlled movements of the food item in the first direction. Therefore, it would be obvious to use a motor, which obviously can include a motor shaft, in Kofman.

19. **Claims 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kofman et al. (US 6,230,073 B1)** in view of **Friedman (US 6,408,595 B1)**.

Regarding **claim 25**, Kofman discloses all the limitations introduced in claim 24.

Kofman fails to disclose wherein the guide mechanism comprises a gear for engaging a rack attached to a bottom surface of the directing tray, the gear using the rotational movement of the motor to move the directing tray in the first direction.

However, Friedman teaches wherein the guide mechanism comprises a gear (4b, Fig. 4; see column 6, lines 9-40) for engaging a rack attached to a bottom surface of the directing tray (see 7, Fig. 3 and column 6, lines 9-40), the gear using the rotational movement of the motor to move the directing tray in the first direction (A motor is obvious in Kofman as noted above in the rejection for claim 24.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Kofman with the teachings of wherein the guide mechanism comprises a gear for engaging a rack attached to a bottom surface of the directing tray, the gear using the rotational movement of the motor to

Art Unit: 2861

move the directing tray in the first direction, found in Friedman, for the purpose of conveying the tray, of Kofman, in the first direction.

20. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable in view of **Kofman et al. (US 6,230,073 B1)** in view of **Friedman (US 6,408,595 B1)**.

Regarding **claim 27**, Kofman, in view of Friedman, teaches a single gear and rack, as noted above in the rejection of claim 25, but does not disclose two gears or racks. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the guide mechanism comprise two gears spaced axially apart for engaging two racks attached to a bottom surface of the directing tray, the two gears using the rotational movement of the motor to move the directing tray in the first direction for the purpose of improving the directional stability when advancing the tray of Kofman, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

21. **Claims 29-30 and 35-36** are rejected under 35 U.S.C. 103(a) as being unpatentable in view of **Kofman et al. (US 6,230,073 B1)**.

Regarding **claim 29**, Kofman teaches all claimed limitations except for at least one other cassette including another recess corresponding to a variable size and shape of another food item in order to receive the another food item therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least one other cassette including another recess corresponding to a variable size and shape of another food item in order to receive the another food item therein for

Art Unit: 2861

the purpose of printing on a differently sized food, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding **claim 30**, Kofman further discloses wherein a depth of the recess of the at least one cassette is determined based upon a thickness of the food item (this is inherent in Kofman), such that a top surface of the food item is positioned an optimal distance from the printing device when the directing tray receiving the at least one cassette and the at least one other cassette is positioned below the printing device (See column 7, lines 52-63, wherein the top surface of the food item is either flush or a notch lower than a rim 88 of the frame.), and wherein a depth of the another recess of the at least one other cassette is determined based upon a thickness of the another food item (this is inherent in Kofman), such that a top surface of the another food item is positioned the optimal distance from the printing device when the directing tray receiving the at least one cassette and the at least one other cassette is positioned below the printing device (See column 7, lines 52-63, wherein the top surface of the food item is either flush or a notch lower than a rim 88 of the frame.).

Regarding **claims 35-36**, please note the rejection as set forth above with respect to claim 30.

Conclusion

Art Unit: 2861

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN SEO whose telephone number is (571)270-1327. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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January 22, 2010